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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 897,772	06 29 2001	Keith D. Allen	R-268	9809

7590 09 09 2002
DELTAGEN, INC.
1003 Hamilton Avenue
Menlo Park, CA 94025

EXAMINER

QIAN, CELINE X

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 09/09/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/897,772

Applicant(s)

ALLEN, KEITH D.

Examiner

Celine Qian

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other

Art Unit: 1636

DETAILED ACTION

Claims 1-27 are pending in the application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10 and 17-19, drawn to a BMP knockout targeting construct, a method of making said construct, a cell comprising said construct, a non-human transgenic animal comprising said construct, and a method of making said transgenic animal, classified in class 536, subclass 23.1, class 800, subclass 18, 22.
- II. Claims 11 and 21, drawn to a method of identifying an agent that modulates the expression of a BMP by using a BMP knockout animal, classified in class 800, subclass 3.
- III. Claims 12, 20 and 22, drawn to a method of identifying an agent that modulates the function of a BMP by using a BMP knockout animal, classified in class 800, subclass 3.
- IV. Claims 13 and 15, drawn to a method of identifying an agent that modulates the expression of BMP by using a BMP knockout cell, classified in class 435, subclass 325.
- V. Claims 14, 15, 23 and 24, drawn to a method of identifying an agent that modulates the function of a BMP gene by using a BMP knockout cell, classified in class 435, subclass 325.

Art Unit: 1636

- VI. Claims 16, 25 and 26, drawn to an agent that modulates the expression of BMP gene, classified in class 536, subclass 24.1.
- VII. Claims 16, 25 and 26, drawn to an agent that modulates the function of BMP gene, classified in class 424, subclass 130.1.
- VIII. Claim 27, drawn to a method of ameliorating a disorder associated with a mutation in a BMP gene, classified in class 514, subclass 44.

The inventions are distinct, each from the other for the following reasons.

Inventions of Group I and II-V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product of Group I can be used in four different methods as claimed in Groups II-V. Therefore, the inventions of Group I are patentably distinct from the inventions of Groups II-V.

Inventions II, IV and VI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product of Group VI can be made by at least two materially different processes, for example, the method claimed in Group II or IV. Therefore, the inventions of Group II, IV are patentably distinct from the inventions of Group VI.

Art Unit: 1636

Inventions III, V and VII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product of Group VII can be made by at least two materially different processes, for example, the method of Groups III or V. Therefore, the inventions of Groups III, V and VII are patentably distinct.

Inventions of Groups I, VI and VII are patentably distinct from the invention of Group VIII because the inventions are drawn to compositions and methods that are not directly related. The compositions of Groups I, VI and VII cannot be used in the method of Group VIII. Therefore, the inventions of Groups I, VI and VII are patentably distinct from the invention of Group VIII.

Inventions of Group I, VI and VII are patentably distinct because the inventions are drawn to materially distinct compositions that are not directly related. The construct and transgenic animal of Group I, the BMP expression modulator of Group VI, and the BMP function modulator of Group VII are biologically, chemically and functionally distinct compositions. Therefore, the inventions of Group I, VI and VII are patentably distinct.

Inventions of Groups II-V and VIII are patentably distinct from each other because the inventions are drawn to methods that require different starting materials and modes of operation. Each method involves distinct method steps from each other. Therefore, the inventions of Groups II-V and VIII are patentably distinct.

Art Unit: 1636

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. A search of the subject matter of one invention would not be co-extensive with a search of the other invention, and therefore the search would be burdensome. Each invention is capable of supporting a separate patent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celine X Qian whose telephone number is 703-306-0283. The examiner can normally be reached on 9:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel can be reached on 703-305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Celine Qian, Ph.D.
July 25, 2002


TERRY MCKELVEY
PRIMARY EXAMINER